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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YENKE, BRIAN P

ART UNIT	PAPER NUMBER
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2622

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04/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,385	Applicant(s) DUMONT ET AL.	
	Examiner BRIAN P. YENKE	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE/Amendment (04/02/10).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-10 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/02/10 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Previously objected to claim 6, now independent claim 10 is now rejected based upon the disclosure having support for a MPEG encoder and decoder, however the specification doesn't provide support for any other type of encoder/decoder (i.e. A/D). Thus the claim is rejected as being broader than what applicant specification discloses. If the applicant disagrees and deems the applicant was entitled to other encoders/decoders besides MPEG, the examiner requests clarification/instances supporting such from the application.

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In part...

Under certain circumstances, omission of a limitation can raise an issue regarding whether the inventor had possession of a broader, more generic invention. See, e.g., *PIN /NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1248, 64 USPQ2d 1344, 1353 (Fed. Cir. 2002) (Claim for a method of inhibiting sprout growth on tubers by treating them with spaced, sequential application of two chemicals was held invalid for lack of adequate written description where the specification indicated that invention was a method of applying a "composition," or mixture, of the two chemicals.); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998) (claims to a sectional sofa comprising, inter alia, a console and a control means were held invalid for failing to satisfy the written description requirement where the claims were broadened by removing the location of the control means); *Johnson Worldwide Associates v. Zebco Corp.*, 175 F.3d 985, 993, 50 USPQ2d 1607, 1613 (Fed. Cir. 1999) (In *Gentry Gallery*, the "court's determination that the patent disclosure did not support a broad meaning for the disputed claim terms was premised on clear statements in the written description that described the location of a claim element--the control means' --as the only possible location' and that variations were outside the stated purpose of the invention." *Gentry Gallery*, 134 F.3d at 1479, 45 USPQ2d at 1503. *Gentry Gallery*, then, considers the situation where the patent's disclosure makes crystal clear that a particular (i.e., narrow) understanding of a claim term is an essential element of [the inventor's] invention.""); *Tronzo v. Biomet*, 156 F.3d at 1158-59, 47 USPQ2d at 1833 (Fed. Cir. 1998) (claims to generic cup shape were not entitled to filing date of parent application which disclosed "conical cup" in view of the disclosure of the parent application stating the advantages and importance of the conical shape.). A claim that omits an element which applicant describes as an essential or critical feature of the invention originally disclosed does not comply with the written description requirement. See *Gentry Gallery*, 134 F.3d at 1480, 45 USPQ2d at 1503; *In re Sus*, 306 F.2d 494, 504, 134 USPQ 301, 309 (CCPA 1962) ("[O]ne skilled in this art would not be taught by the written description of the invention in the specification that any aryl or substituted aryl radical' would be suitable for the purposes of the invention but rather that only certain aryl radicals and certain specifically substituted aryl radicals [i.e., aryl azides] would be suitable for such purposes.") (emphasis in original). A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may also be subject to rejection under 35 U.S.C. 112, para. 1, as not enabling, or under 35 U.S.C. 112, para. 2. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); and *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). See also MPEP § 2172.01.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill

in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho, US 5,680,176 in view of EP-1128637 in view of US 2002086320.

a) the claimed a digital encoder is met by A/D 44 which encodes the analog signal into a digital signal (broadest interpretation of a digital encoder, no compressively encoding as disclosed).

b) the claimed a digital decoder is met by D/A 52 which is connected to the caption data detection ckt 46 which receives the digital encoded signal from circuit 44

c) the claimed control means is met by control signal generation circuit 54, which receives the horizontal and vertical signals from the input signal (Fig 3) in addition to the caption detection ckt 46 which detects the VBI data (periodic)

d) the claimed selecting means...is met by video signal switching circuit 56 which outputs either the input analog signal (from clamping circuit 42) or the caption data (when said window occurs based upon the sync/clock data from 54 via D/A 52).

e) the claimed wherein the digital decoder...is met where the D/A circuit receives the clock signal based upon the sync signal (Fig 3).

However, as stated by applicant Cho does not explicitly recite an MPEG encoder/decoder, wherein the use of an MPEG encoder/decoder provides the ability to compress/decompress information, thereby reducing bandwidth, providing more information in the same band etc... as known to one of ordinary skill in the art. The examiner relies upon applicant's previously submitted EP-1128637, which discloses such (MPEG encoder 116 (Figs 2c/d and MPEG decoder 122, Figs 2c/d).

The motivation for modifying Cho with EP-1128637 would provide the ability to compress/decompress data which provide the advantages as noted above.

Regarding the exclusivity from limitations, the examiner evidences Carlsgaard, US 2002086320, which discloses a same program both in standard definition and one in high definition (i.e. MPEG encoded), where the

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digital video signal (which was encoded and then decoded) is combined with the analog signals caption data, as done with the current invention.

Thus the features of combining a digital video signal, with it's analog version caption data (which is not included in the digital signal) is known.

The motivation for modifying Cho and EP-1128637 would provide the ability to receive HDTV signals and in the event caption data was not available with the provided signal, the caption data from the same program (analog version) could be used to provide the user/viewers such information.

In considering claim 2,

Is met by D/A which receives the vertical and horizontal sync signal from the analog input signal.

In considering claim 3,

Is met where the system of Choi adds the captioning/VBI data during the blanking portion (high during periodical time interval corresponding to said time window as claimed).

In considering claim 4,

The applied Cho discloses the use of a luminance signal, thus not explicitly recite the "CVBS" signal as claimed, although as described in applicant's disclosure the use of either/or would be an alternative, thus being an obvious to one of ordinary skill in the art, since both types of signals provide the same result.

In considering claim 5,

The control circuit 54 along with caption detection circuit 46 which provides the active video and caption data for display.

In considering claim 7,

Cho discloses the digital encoder 44 and digital decoder 52 connected caption detection circuit 46 and switch 56, the medium interface being the detection circuit.

In considering claim 8,

Cho discloses a display device 50.

In considering claim 9,

Refer to claim 1 above.

Allowable Subject Matter

4. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Yenke whose telephone number is (571)272-7359. The examiner work schedule is Monday-Thursday, 0730-1830 hrs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, David L. Ometz, can be reached at (571)272-7593.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(571)-273-8300

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is

(703)305-HELP.

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/BRIAN P. YENKE/
Primary Examiner, Art Unit 2622

B.P.Y
20 Apr 10

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